

### REMARKS

This application claims priority to International Application PCT/DE00/01259. Applicants would like to point out that the filing date of this International Application is April 20, 2000, instead of July 20, 2000 as appeared on the Official Filing Receipt (copy attached as Exhibit A). See the cover sheet of International Application PCT/DE00/01259, a copy of which is attached as "Exhibit B." **Applicants request that a corrected Official Filing Receipt be issued.**

Applicants have corrected minor deficiencies in claims 1-4, 19-21, 25, and 36-38. No new matter has been introduced by the above amendments.

Claims 1-38 are currently pending. Reconsideration of the application, as amended, is requested in view of the remarks below.

#### Rejection under 35 U.S.C. § 112, second paragraph

Claims 1-38 are rejected as being indefinite on two grounds. Applicants traverse each ground below:

(1) The Examiner points out that "[i]t is unclear what products by process are encompassed by the term 'obtainable' and it would require undue experimentation to determine all of the products by other processes which are intended to be encompassed by the instant claims." See the Office Action, page 2, lines 1-7. Applicants have replaced the term "obtainable" recited in claims 1-4, 20, and 21 with "obtained" to clearly indicate that the claims only encompass the products (i.e., a polymer microparticle or a polyesterpolyol) prepared by the processes recited in these claims. In other words, amended claims 1-4, 20, and 21 do not encompass products prepared by other processes and therefore no undue experimentation is required.

(2) The Examiner indicates that "[c]laims 36-38 provide for the use of the claimed polymer microparticles, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass." See the Office Action, page 3, lines 18-22. Applicants have rephrased claims 36-38 to clearly point out the methods that Applicants intend to encompass (i.e., methods of preparing an aqueous or

solventborne coating composition). Specifically, a method of each of amended claims 36-38 includes a step of adding a polymer particle in an aqueous or organic solution.

For the reasons set forth above, Applicants submit that claims 1-38 are no long indefinite and request withdrawal of this rejection.

#### Rejection under 35 U.S.C. § 101

Claims 36-38 are rejected as not being proper process claims. Specifically, the Examiner points out that "the claimed recitation of a use, without setting forth any steps involved in the process, results in a improper definition of a process." See the Office Action, page 4, lines 1-4.

As mentioned above, a method of each of amended claims 36-38 includes a step of adding a polymer particle in an aqueous or organic solution. Therefore, claims 36-38 are proper process claims.

#### Double patenting

Claims 1-38 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of Muller et al., U.S. Patent 6,538,059 in view of Oshima et al., U.S. Patent 5,280,075. See the Office Action, page 5, lines 21-23.

In the sole interest of moving this application toward allowance, Applicants have submitted a terminal disclaimer herewith and request withdrawal of this rejection.

#### CONCLUSION

Applicants submit that the grounds for rejection asserted by the Examiner have been overcome, and that claims 1-38, as pending, define subject matter that is definite. On this basis, it is submitted that all claims are now in condition for allowance, an action of which is respectfully requested.

Applicant : Horst Muller et al.  
Serial No. : 10/030,526  
Filed : October 19, 2001  
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Attorney's Docket No.: 13619-002001 / 183/98004US-1

Enclosed is a check for the Petition for Extension of Time fee. Please apply any other charges to deposit account 06-1050, referencing Attorney's Docket No. 13619-002001.

Respectfully submitted,

Date: 4-16-04

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